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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIA AZUA HIMMEL, HERMAN RODRIGUEZ,
NEWTON JAMES SMITH, JR., and CLIFFORD JAY SPINAC

Appeal 2007-3629
Application 10/047,837
Technology Center 2100

Decided: June 17, 2008

Before JAMES D. THOMAS, JOSEPH L. DIXON, and STEPHEN C. SIU,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-11 and 13-39. Claim 12 has been canceled and claim 17 has been objected to. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION under 37 CFR § 41.50(b).

BACKGROUND

Appellants' invention relates to a system and method for telephone number capture from a Web page. (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for sending a telephone number record into a communications terminal having an electronic telephone directory, comprising:

recording in a web browser a destination address of the communications terminal having the electronic telephone directory,

capturing one or more telephone number records from a Web page; and

sending a message containing the one or more captured telephone number records from a captor computer to the destination address of the communications terminal, wherein the captor computer is selected from a computer running the web browser or a server hosting the Web page.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Rossmann	US 2004/0111669 A1	Jun. 10, 2004
Hirabayashi	US 2002/0022923 A1	Feb. 21, 2002

REJECTIONS

Claims 1-2, 5-10, 21-24, 26-28, 31-33, 35 and 37-39 stand rejected under 35 U.S.C. 102(e) as being anticipated by Rossmann. Claims 3-4, 16¹ and 29-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann, as applied to claims 1-2, 5-10, 21- 24, 26-28, 31-33, 35 and 37-39 above, further in view of Official Notice. Claims 11, 13-15, 18-20, 25, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Nov. 27, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Apr. 6, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103(a)

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in

¹ Note that claims 16 was not included in the introductory statement of the rejection, but was discussed at page 8 of the Answer.

the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

With respect to independent claim 37, this independent claim does not contain the same problematic language and variation in scope as do independent claims 1, 21, and 27, which we discuss later in the New Ground of Rejection. Therefore, we will address Appellants' arguments with respect to independent claim 37. Appellants restate the language of independent claim 37 and argue that Rossmann does not disclose or teach a method that includes sending a message containing one or more captured telephone number records from a server hosting a Web page to a destination address of a communications terminal. (App. Br. 9). While the scope of independent claim 37 is slightly varied from that of independent claim 1, and the Examiner merely stated a singular rejection based upon independent claim 1, we will evaluate the teachings of Rossmann as applied by the Examiner. The Examiner maintains that Rossmann teaches the use of a personal information manager (PIM) as a phone book [0009] and that phone numbers may be copied and pasted into the PIM. (Answer 3-5 and 11-13). From our review of the teachings of Rossmann, we find various alternatives in extracting information including phone number information from a Web page along with use and storage thereof. (e.g., [0044], [0045], [0060], [0063], [0068], [0079], and [0081]). From these teachings, we agree with the Examiner that Rossmann teaches extraction of phone number data from a Web page and storage of that information at a separate user computer. We find that Rossmann teaches both the server pushing the information to the

user computer or the user acquiring the information. We find the language of the independent claim 37 to be broad enough to be interpreted either way and Rossmann teaches both alternatives.

Moreover, we do not find any specific arguments for patentability which specifically address the merits of independent claim 37 beyond mere reiteration of the claim language in the general assertion that they are not taught by Rossmann. Therefore, we do not find Appellants' argument persuasive of error in the Examiner's initial showing of anticipation, and we will sustain rejection of independent claim 37 and dependent claims 38 and 39 grouped therewith by Appellants.

Considering now the rejections of claims 1-11 and 13-36 under 35 U.S.C. §§ 102 and 103, we have carefully considered the subject matter defined by these claims. However, for reasons stated *infra* in our new rejection under the second paragraph of Section 112 of Title 35 entered under the provisions of 37 CFR 41.50(b), no reasonably definite meaning can be ascribed to certain language appearing in the claims. As the court in *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) stated:

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious --the claim becomes indefinite.

In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and

assumptions, *see In re Steele*, 305 F.2d 859, 862 (CCPA 1962), we are constrained to reverse, pro forma, the Examiner's rejections of claims 1-11 and 13-36 under 35 U.S.C. §§ 102 and 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the sections 102 and 103 rejections.

New Grounds of Rejection

At the outset, we note that the Examiner set forth the following Objection to most of the pending claims:

Claims 1-36 are objected to because of inconsistency found in the claim language. That is the specification consistently indicates that the word "captor" refers to a person who uses a computer to surf the Internet, to interactively select displayed telephones, and to activate a program for automatically storing the telephone number in an electronic telephone directory [see, e.g., paragraphs 7-9 and 32-35]. However, the amended claim language at claim 1 lines 8-9; claim 21 lines 10-11 and claim 27 lines 10-11 indicates that the captor is "selected from a computer running the browser or a server hosting the Web page. Clarification and/or correction is required in response to this office action.
(Final Rej. 2).

We note that in the Advisory Action, mailed February 1, 2006, the Examiner does not expressly withdraw the objection to these claims, but does allow the amendment to be entered and the Examiner further postulates the use of a cut-and-paste of a telephone number into a telephone directory. Therefore, we are left to wonder if the Examiner's objections were obviated. The listing on the cover page with respect to "objected" is directed to formal matters of claim dependency on rejected claims.

While we do not address objections and formal matters, from our review of Appellants' Specification and drawings, we have similar concerns as expressed in the objection and find that the Specification is drafted as the Examiner indicated concerning the captor computer as a computer with the browser 15 as shown in figure 1. Therefore, it is unclear to us how the "captor computer" is selected from one of two choices, as recited in independent claim 1, 21, and 27. Moreover, when we look to the Summary of the Claimed Invention as set forth in the Brief at pages 2-4, we find no clear correspondence between the Specification and the recited claim limitations as required by 37 CFR 41.37 (c)(1)(v). Here, Appellants merely provide a laundry list of pages and line numbers without further concise explanation, as required. Moreover, these portions of the Specification are drawn to various embodiments and alternatives for the storage of the telephone number directory which are shown in figure 1. Therefore, Appellants' Brief is not helpful in clarifying the proper interpretation of the instant claim language.

Therefore, we are left to speculate as to where the telephone number directory is located, thereby requiring us to speculate in the evaluation of the prior art teachings of Rossmann as they apply to the instant claim language. This we will not do, and we do not find the enumerated independent claims to sufficiently identify the metes and bounds of the claimed invention so that a valid comparison to the prior art teachings of Rossmann may be performed. Therefore, we reject independent claims 1, 21, and 27 under 35 U.S.C. § 112, second paragraph as failing to particulate point out and

distinctly claim the invention. Additionally, dependent claims 2-11 and 13-20, 22-26, and 28-36 contain the same deficient subject matter as the respective independent claims.

For example, we note that the portions of the Specification identified in the Brief discussed above with respect to the Summary of the Claimed Invention of independent claim 1 identify at page 5 of the Specification, that the captor computer sends the information or alternatively the server sends the information. Then at page 7 of the Specification, the server delivers the information. Then at page 9 of the Specification, the process is performed automatically and again may be performed at the captor computer or the server computer. Here, we find each alternative to be directed to a different hardware configuration and methodology, and we are unclear as to the appropriate scope of independent claim 1.

Alternatively, we are unsure if Appellants desire the alternative language in the claims to set forth two different hardware embodiments or a single embodiment with both functionalities that a user would make a selection between.

Additionally, with respect to independent claim 27, which is drafted as a computer program product including instructions embodied on a computer readable medium, we are unclear as to whether this singular program product is located at a server or the computer with the browser. Here, it appears that the recording instructions would be at the Web browser, but the capturing instructions would be at the server, and the sending instructions may be at either the server or the computer with the browser.

Therefore, we are unsure of how independent claim 27 recites a singular computer program product or article of manufacture. Therefore, we are unclear as to how to interpret independent claim 27 and the appropriate scope of the claim limitations.

CONCLUSION

To summarize, we have sustained the rejection of claims 37-39 under 35 U.S.C. § 102 and we have reversed the rejection of claims 1-11 and 13-36 under 35 U.S.C. §§ 102 and 103. We have also introduced a new ground of rejection as to claims 1, 21, and 27 and their corresponding dependent claims under the second paragraph of 35 U.S.C. § 112.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART
37 CFR § 41.50(b)

pgc

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